

REMARKS

Applicants respectfully submit that the claims have been amended, and claims 2, 5, 6, 10, 14, 15, 19, 22, and 23 have been canceled without prejudice, to more clearly point out the present invention. All the claims presently on file are in condition for allowance, which allowance is earnestly solicited.

CLAIMS REJECTION UNDER 35 U.S.C. 112

Claims 1-25 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the claims were rejected based on the use of the term "first level". Applicants have addressed the informality in compliance with 35 U.S.C. 112.

CLAIMS REJECTION UNDER 35 U.S.C. 102

Claims 1, 4, 5, 9, 13, 14, 18, 21 and 22 were rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ullmann et al., US 2002/0198983 (hereinafter "Ullmann"). Applicants respectfully submit that Ullmann does not disclose all the elements and limitations of the claims on file. Consequently, the claims on file are not anticipated under 35 U.S.C. 102, and the allowance of these claims and the claims dependent thereon are earnestly solicited. In support of this position, Applicants submit the following arguments:

A. Legal Standard for Lack of Novelty (Anticipation)

The standard for lack of novelty, that is, for "anticipation," is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements, and the burden of proving such anticipation is on the party making such assertion of anticipation. Anticipation cannot be shown by combining more than one reference to show the elements of the claimed invention. The amount of newness and usefulness need only be minuscule to avoid a finding of lack of novelty.

The following are two court opinions in support of Applicants' position of non anticipation, with emphasis added for clarity purposes:

- "Anticipation under Section 102 can be found only if a reference shows exactly what is claimed; where there are differences between the reference disclosures and the claim, a rejection must be based on obviousness under Section 103." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).
- "Absence from a cited reference of any element of a claim of a patent negates anticipation of that claim by the reference." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986), on rehearing, 231 USPQ 160 (Fed. Cir. 1986).

B. Application of the Legal Standard of Anticipation to the Present Invention

The allowability of the claims will now be discussed in light of representative claim 1. In regard to claim 6, the Examiner states that "Ullmann does not expressly disclose "...the third predetermined value is a history trace level." Claim 6 has now been canceled without prejudice, and its limitation is recited in the current claim 1 as amended.

Consequently, in view of the strict anticipation standard, claim 1 is not anticipated by Ullmann, for reciting a limitation that is admittedly not included in the cited reference. The claims dependent on claim 1 are therefore also not anticipated by Ullmann. Independent claims 9 and 18 are allowable for containing a similar subject matter to that of claim 1. Therefore, claims 9 and 18 and the claims dependent thereon, are also allowable.

CLAIMS REJECTION UNDER 35 U.S.C. 103

Claims 2, 6-8, 10, 11, 15-17, 19, and 23-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ullmann.

Applicants respectfully submit that the cited references do not disclose all the elements and limitations of the claims on file as a whole. Consequently, the claims on file are not obvious under 35 U.S.C. 103, and the allowance of these claims is earnestly solicited. The allowability of the rejected claims will now be discussed in view of representative claim 1 that has been amended to recite the limitation of claim 6.

The Examiner indicates that: "Ullmann does not expressly disclose "...the third predetermined value is a history trace level." However, Ullmann does disclose a history trace".

Applicants respectfully traverse this rejection ground and submit that Ullmann does not log the history data for a specific program activity based

on the history trace level. As a result a clear distinction should be made between "history data" and "history data level" that initiates the logging of the history data.

In addition, although Ullmann describes a trigger, such trigger is quite distinct from the trap value of the present invention. Claim 1 has been amended to clarify that the trap value is used as a trigger to initiate the logging of the history data for a specific program activity. In other term, while triggering a logging event, in general, is a well known step, the present invention specifically describes a trap value to initiates the logging of the history data, based upon the severity of the history data. Applicants submit that the Ullmann does not appear to describe this specific feature.

In addition, claim 1 has now been amended to clarify the selective need to resize the trace buffer. No such resizing of the trace buffer is described in the prior art.

To summarize, the office action seems to dissect the elements of the claims, **without considering the invention as a whole**. Consequently, Applicants respectfully submit that Ullmann does not consider the present invention as a whole, necessitating the finding of non-compliance with the foregoing legal standard. Reference is made to the following legal authority in support of the finding of non-obviousness:

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. The prior art perceived a need for mechanisms to dampen resonance, whereas

the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700."

The Examiner resorts to the general knowledge in the field to compensate for the missing elements of Ullmann, indicating that: "It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to log the "history trace level" in the event of an error in order to reconstruct the problem to achieve the benefits old are well known in the art of program debugging by reconstructing the problem."

Applicants respectfully traverse this rejection ground, and submit that the Examiner has not provided any support for this ground with the exception of a general comment that logging the history trace level is known. Applicants submit that if the Examiner wishes to rely on such rejection ground, then the Examiner is requested to submit evidence in support of the Examiner's position.

In addition, Applicants respectfully submit that Ullmann **does not provide any reasonable teaching or suggestion** to support modifying its teaching in order to log the "history trace level" in the event of an error, to reconstruct the problem for achieving the benefits old are well known in the art of program debugging by reconstructing the problem."

In response, Applicants respectfully submit that the general concept of achieving the benefits of program debugging by reconstructing the

problem, lacks the necessary specificity to be considered as reasonable teaching or suggestion to support the modification of Ullmann. The hindsight addition of the missing feature to those of the primary reference (Ullmann), without a well founded reason to support such modification does not support a prima facie ground for a proper obviousness rejection. Consequently, the combination of Ullmann and the general comment made by the Examiner, is untenable.

As a result, the hypothetical combination of Ullmann and the Examiner's general comment cannot be used to support a finding of obviousness, as indicated by the legal authorities below:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). What a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact. See *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984)."

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *MPEP* 2143.01; *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

Claim 1 is thus not obvious in view of the cited reference, and the allowance of this claim and the claims dependent thereon, is earnestly solicited. Independent claims 9 and 18 are allowable for containing a similar subject matter to that of claim 1. Therefore, claims 9 and 18 and the claims dependent thereon, are also allowable.

CONCLUSION

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

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Respectfully submitted,

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